REMARKS/ARGUMENTS

Claims 1-16 are currently pending in the application. No claims have been amended at this time.

Applicant wishes to thank the Examiner for indicating that claims 3-16 are only objected to, in which the limitations of these claims may be allowable.

Reconsideration is requested of claims 1 and 2 in view of the following remarks.

Rejections under 35 U.S.C. § 103

The rejection of claims 1 and 2 under 35 U.S.C. § 103(a) as obvious over EP 0274 401 ("EP 401") is respectfully traversed for the reasons discussed below.
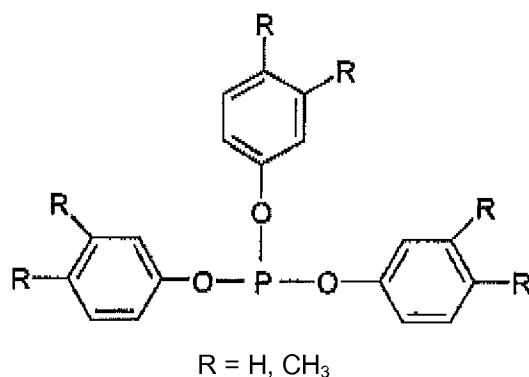
As acknowledged and appreciated by the Office, claims 1 and 2 differ from the reference due to the recitation of the molar ratio of the 1,3 butadiene to the hydrogen cyanide of from 1.6:1 to 1.1:1. However, the Office asserts that it would be obvious to vary the range or achieve the same results, in the absence of unexpected results.

In response, Applicant points out, as the Board of Patent Appeal and Interferences has recently confirmed, an obviousness determination requires that the Office make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." *See In re Ward and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original); *see also Ex parte Martin Haubner and Rolf Pinkos*, Appeal No. 2009-0449 (explaining that " in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of prima facie obviousness," and finding that the process claims were <u>not</u> obvious over the cited combination of references). Moreover, as the Supreme Court stated, *"there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

In the present case, the claimed process for continuously hydrocyanating 1,3-butadiene in the presence of at least one catalyst is clearly not described or suggested by EP 401.

In particular, Applicant points out, *inter alia*, that the Ni (0)-complexes with phosphite esters according to EP '401 (see page 2, lines 24 to 28) have the formula $Ni [P (OR_3)_3]_4$, in

which die ligands are phosphite esters of mixtures of phenol, m-cresol and p-cresol. The ligands are therefore triphenylphosphite, which may be substituted in m- and p- positions by methyl groups as shown below:

R = H, CH3

These ligands contain only one phosphor atom; therefore, those ligands are monodentate ligands.

According to the present invention, chelate ligands of formula (I) are used (see pages 2 and 3 of the present specification), all of which are bidentate ligands, since they contain two phosphor atoms.

Therefore, at least for the additional reason that the phosphorus chelate ligands are not the same or suggested by EP '401, the claimed process is novel and unobvious. Accordingly, withdrawal of the rejection is respectfully requested.

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees to Deposit Account No. 03-2775.

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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00312-US1 from which the undersigned is authorized to draw.

Dated: July 16, 2009   Respectfully submitted,

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